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P.O. BOX 802333			ART UNIT	PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<u> </u>						
	Application No.	Applicant(s)				
	09/833,339	DUTTA ET AL.				
Office Action Summary	Examiner	Art Unit				
	Timothy M. Harbeck	3628				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DATE - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  If NO period for reply is specified above, the maximum statutory period was realiure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tim rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	the mailing date of this communication.  D (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed on 19 Ma	Responsive to communication(s) filed on 19 May 2006.					
· <u></u>	·—					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims						
4)	vn from consideration. 0,41-43 and 45-56 is/are rejected.					
Application Papers						
9) The specification is objected to by the Examiner 10) The drawing(s) filed on is/are: a) access applicant may not request that any objection to the conference of the	epted or b) objected to by the Edrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).				
Priority under 35 U.S.C. § 119						
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>						
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	4)  Interview Summary Paper No(s)/Mail Da 5)  Notice of Informal P					
Paper No(s)/Mail Date <u>7/17/2006</u> .	6)					

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#### **DETAILED ACTION**

# Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-6, 13-15, 17-18, 25-27, 29-30, 37-39, 41-42, 49, 51, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson et al (hereinafter Stinson; US PAT 6,786,398) in view of Anderson et al (hereinafter Anderson US PAT 6,021,202) in view of Zajkowski et al (hereinafter Zajkowski US PAT 6,705,517) in view of Rhoads (US 2001/0022848 A1) in view of Jeffords (Raymond Jeffords, Greg Thibadoux, Marsha Scheidt. "New Technologies to combat check fraud." The CPA Journal. New York: Mar 1999. Vol.69, iss. 3; pg. 30, 5 pgs).

**Re Claim 1**: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising:

- Receiving a customer check issued by a customer at the automatic teller machine (Column 1, lines 58-61)
- Identifying an amount for the customer check (Column 1, lines 63-64)
   Stinson does not explicitly disclose
  - Scanning the customer check to create an image of the check
  - Creating a new printed certified check for the amount, wherein the new printed certified check includes a digital watermark identifying a financial

institution for an account on which the customer check is issued and wherein funds for the amount are guaranteed by the financial institution

Sending a check use alert to customers associated with the account

Anderson discloses a method and system for processing electronic documents wherein an electronic check is created at an ATM machine (Column 22, lines 63-67) and wherein the funds for the amount are guaranteed by a financial institution (Column 23, lines 5-11). While Anderson does not explicitly disclose printing the new check, it is old and well known to be able to print a hard copy version of an electronic document and furthermore, Zajkowski discloses that negotiable financial instruments like checks can be dispensed from automated banking machines (Column 1, lines 40-43). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Anderson and Zajkowski to the disclosure of Stinson so that a user could convert a first negotiable instrument into a second that is essentially a cash equivalent. A user may not want to simply cash the check for fear of losing a large sum of money, whereas with a check there is a higher degree of security should that instrument be lost or stolen. Furthermore, if the customer can print the new check as a hard copy form, it can be personally transferred to the appropriate recipient.

Rhoads discloses the old and well known method of digital watermarking a security document such as negotiable financial instruments (page 1; paragraph 0008), wherein the security document (check) includes a digital water mark identifying a financial institution for an account on which the customer check is issued (page 2, paragraph 0019). It would have been obvious to anyone skilled in the ordinary art at the

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time of invention to include the digital watermarking procedures of Rhoads to the disclosure of Stinson / Anderson / Zajkowski to provided additional security measures to the check, including discouraging counterfeiting, transferring information through the documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

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Finally Jeffords discloses scanning a customer check to create an image of the customer check (page 4, fifth full paragraph "With the introduction of scanning and electronic imaging software...") and sending a check use alert to the customer associated with the account (page 4, second full paragraph "Details of checks not found on the listing are forwarded to the customer for verification and approval."). It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps in order to further protect both customers and financial institutions from potential fraudulent transactions. By both scanning checks and alerting customers of problems, fraudulent transactions can be more quickly identified, recorded and rectified by the parties involved.

Re Claim 2: Stinson in view of Anderson / Zajkowski / Rhoads / Jeffords / discloses the claimed method supra and Anderson further discloses the step comprising verifying funds are available in the account on which the customer check is issued prior to creating the new printed certified check (Column 24, lines 29-37).

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**Re Claim 3:** Stinson in view of Anderson / Zajkowski / Rhoads / Jeffords / discloses the claimed method supra and Zajkowski further discloses dispensing the new printed certified check to the customer at the automatic teller machine (Column 41-44).

Re Claim 5 and 6: Stinson in view of Anderson / Zajkowski / Rhoads / Jeffords discloses the claimed method supra and Anderson further discloses wherein the new printed certified check is sent to the third party designated by the customer at the automated teller machine or as an electronic certified check (Column 23, lines 54-56). A user of the combined system would simply print the new certified check, then insert this new check into the ATM machine for processing and forwarding as either a paper check or an electronic check.

Re Claims 13-15 and 17-18: Further data processing system would have been necessary to perform previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Re Claims 25-27 and 29-30: Further data processing system would have been necessary to perform previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Re Claims 37-39 and 41-42: Further computer program product would have been necessary to run previously rejected method claims 1-3 and 5-6 respectively and are therefore rejected using the same art and rationale.

Re Claims 49, 51, 53 and 55: Stinson in view of Anderson / Zajkowski / Rhoads / Jeffords discloses the claims supra and Jeffords further discloses wherein an image of the customer is captured in response to receiving the check (Page 6, 2<sup>nd</sup> and 3<sup>rd</sup> full

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paragraphs "various facial dimensions," biometrics.). While Jeffords does not explicitly disclose wherein the check use alert includes the image of the customer attached to the image of the customer check, Official Notice is taken that this is an old and well known step in the art. It would have been obvious to a person of ordinary skill to include this step in order to further assist in combating check fraud. By attaching the customer image to the check image, the customer can verify if they are in fact the person in the photo, or if it is someone else. Furthermore, it is well known that many instances of fraud or identify theft involve persons familiar to the victim, and therefore said victims would be able to quickly identify the party in question and this information can be forwarded to the appropriate authorities. This additional layer of security serves as both a deterrent to fraud and a means to assist in the apprehension of fraudulent parties.

Claims 7, 19, 31, 43, 50, 52, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads in view of Jeffords.

**Re Claim 7**: Stinson discloses a method for processing checks comprising:

 Receiving a check from a customer at the automatic teller machine (Column 1, lines 58-61)

Stinson does not explicitly disclose the steps of

- Scanning a check to create an image of the check
- Searching the image of the check for an overlaid digital watermark
   identifying a financial institution for an account on which the check is
   issued

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Responsive to identifying the digital watermark in the image, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; and

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- Responsive to the digital watermark being authentic, providing financial services to the customer
- Sending a check use alert to customers associated with the account

Rhoads discloses a method of producing a security document wherein a check (security document) is scanned (see abstract or paragraph 0019) to create an image of the check (see "photocopied" paragraph 0019); Searching the image of the check for an overlaid digital watermark identifying a financial institution for an account on which the check is issued (end of 0019 or FIG 12 "watermark detector"); Responsive to identifying the digital watermark in the image, determining whether the overlaid digital watermark is authentic by comparing the overlaid digital watermark identified in the image of the check to a watermark associated with the financial institution for the account on which the check is issued to see if a match occurs, wherein the overlaid digital watermark is authentic if the match occurs; (0019) and; Responsive to the digital watermark being authentic, providing the financial services to the customer (see passport example in paragraph 0019; applicable to a bank customer and their account information).

It would have been obvious to anyone skilled in the ordinary art at the time of invention to include the teachings of Rhoads to that of Stinson in order to provide additional security measures to the check, including discouraging counterfeiting, transferring information through the documents without alerting human viewers to the presence of the information (Rhoads, paragraph 0008), or identifying a financial institution linked to the document (Rhoads, paragraph 0019).

Jeffords discloses scanning a customer check to create an image of the customer check (page 4, fifth full paragraph "With the introduction of scanning and electronic imaging software...") and sending a check use alert to the customer associated with the account (page 4, second full paragraph "Details of checks not found on the listing are forwarded to the customer for verification and approval."). It would have been obvious to a person of ordinary skill in the art at the time of invention to include these steps in order to further protect both customers and financial institutions from potential fraudulent transactions. By both scanning checks and alerting customers of problems, fraudulent transactions can be more quickly identified, recorded and rectified by the parties involved.

**Re Claim 19**: Further data processing system would have been necessary to perform previously rejected method claim 7 and is therefore rejected using the same art and rationale.

**Re Claim 31**: Further data processing system would have been necessary to perform previously rejected method claim 7 and is therefore rejected using the same art and rationale.

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**Re Claim 43**: Further computer program product would have been necessary to run previously rejected method claim 7 and is therefore rejected using the same art and rationale.

Re Claims 50, 52, 54 and 56: Stinson in view of Anderson / Zajkowski / Rhoads / Jeffords discloses the claims supra and Jeffords further discloses wherein an image of the customer is captured in response to receiving the check (Page 6, 2<sup>nd</sup> and 3<sup>rd</sup> full paragraphs "various facial dimensions," biometrics.). While Jeffords does not explicitly disclose wherein the check use alert includes the image of the customer attached to the image of the customer check, Official Notice is taken that this is an old and well known step in the art. It would have been obvious to a person of ordinary skill to include this step in order to further assist in combating check fraud. By attaching the customer image to the check image, the customer can verify if they are in fact the person in the photo, or if it is someone else. Furthermore, it is well known that many instances of fraud or identify theft involve persons familiar to the victim, and therefore said victims would be able to quickly identify the party in question and this information can be forwarded to the appropriate authorities. This additional layer of security serves as both a deterrent to fraud and a means to assist in the apprehension of fraudulent parties.

Claims 9-10, 21-22, 33-34 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Rhoads in view of Jeffords as applied to claims7, 19, 31 and 43 above, and further in view of Anderson.

Re Claim 9: Stinson in view of Rhoads in view of Jeffords discloses the claimed method supra but does not explicitly disclose the step of providing financial services to the customer comprises determining whether funds are available in the account on which the check is issued to cover an amount of the check. Anderson discloses such a step (Column 24, lines 28-36) and it would have been obvious to anyone of ordinary skill to include this step to the teaching of Stinson and Rhoads and Jeffords so that an issued check does not bounce because of insufficient funds. This is an old and well known step in banking and helps to eliminate future problems concerning inadvertent overdrafts of funds or potential fraud.

Re Claim 10: Stinson in view of Rhoads in view of Jeffords and further in view of Anderson discloses the claimed method supra and Anderson further discloses the step of initiating a funds transfer for the amount of the check in response to a determination that funds are available to cover the amount of the check (Column 24, lines 31-37).

Re Claims 21-22: Further data processing system would have been necessary to perform previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

Re Claims 33-34: Further data processing system would have been necessary to perform previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

Re Claims 45-46: Further computer program product would have been necessary to run previously rejected method claims 9 and 10 respectively and are therefore rejected using the same art and rationale.

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Claims 11-12, 23-24, 35-36 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Lemelson (US Pat No 4,991,205) in view of Cuervo (US PAT 6,105,009).

Re Claim 11: Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising

- Verifying an identification of the user (Column 1 line 67- Column 2 line 2)
- Responsive to the identification of the user being verified, capturing an image of the user and retrieving user information associated with the user (Column 2, lines 14-34)

Stinson does not explicitly disclose the steps wherein this information is stored on an identification card and this card is generated at the automatic teller machine.

Lemelson discloses a personal identification system and method wherein one object is to "provide a credit card recording and reproduction system for rapidly and easily recording signals relating to a physical characteristic of the card owner on the card which recording may be reproduced by specialized equipment and employed to generate images of the face and signature of the card owner. (Column 1, line 65-Column 2, line 2)" It would have been obvious to someone skilled in the ordinary art at the time of invention to include the identification card taught by Lemelson to the biometrics verification method of Stinson so that a large central database of names does not need to be kept and referenced every time a person uses an ATM. If the data

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is stored on an individual card, provided by the user, then the system need only to read the information on the card, therefore saving memory space and money.

Stinson and Lemelson do not explicitly disclose the step of generating the identification card, however Cuervo discloses an automated teller machine dispenser of debit cards that discloses such a step including recording information about a customer and creating and dispensing the card (Fig 1 Ref 20; and Fig 2). It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this step to the disclosure of Stinson and Lemelson so that someone using an ATM for the first time could have an identification card produced for them for future visits so they do not have to waste time in proceeding through a long verification process for each subsequent visit. Producing the card at the ATM vestibule is advantageous as well as a customer can simply perform this action once before their initial transaction as opposed to having to go out of the way to a central office to have a card generated.

Re Claim 12: Stinson in view of Lemelson in view of Cuervo discloses the claimed method supra and Cuervo further discloses dispensing the identification card to the user (Fig 1, ref 24).

Re Claims 23 and 24: Further data processing system would have been necessary to perform previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

Re Claims 35 and 36: Further data processing system would have been necessary to perform previously rejected method claims 11-12 respectively and are therefore rejected using the same art and rationale.

Re Claims 47 and 48: Further computer program product would have been necessary to run previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

## Response to Arguments

Applicant's arguments filed 5/19/2006 have been fully considered but they are not persuasive.

The Jeffords has been included in response to the amended claim limitations.

Jeffords shows the steps of "scanning the customer check to create an image of the customer check," and "sending a check use alert to customers associated with the account." Jeffords also shows how customer imaging and biometric data is used to combat fraud in the banking industry. Furthermore, Jeffords shows other fraud prevention techniques, relevant to the present application, such as digital watermarking. While these features of Jeffords were not relied upon in this rejection, their relevance is still noted.

Applicant makes many similar concessions about the references and what they disclose (Even though Stinson teaches....Page 13; Even though Rhoads teaches...Page 14; Even though Zajkowski discloses... Page 15) but concludes that no teaching exists in the prior art to combine the references and that the examiner uses improper hindsight reasoning. In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore it has been held that a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The problem to be solved involves facilitating, validating and verifying transactions at an ATM machine. The examiner maintains that the references show all the claimed features as cited in the previous action and furthermore that there is sufficient motivation to combine the references, specifically to provide multiple layers of protection for customers and banks against potential fraud.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding applicants arguments that Rhoads does not teach comparing the overlaid watermark to a watermark associated with the financial institution to see if a match occurs, the examiner disagrees. The inherent purpose of a watermark is for identification purposes. Therefore in applying a digital watermark, and having a "watermark detector" (FIG 12), the examiner maintains that this limitation is disclosed.

Regarding applicants arguments that the disclosed references applied against claims 11, 12, 23, 24,35, 36, 47 and 48 do not suggest all the limitations or the proper motivation the examiner disagrees. Again, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). In this instance the applicant concedes that Stinson teaches "verifying an identification of the user, capturing an image of the user, and retrieving user information associated with the user" (Remarks page 22), and that Lemelson teaches reading the information contained within magnetic recording material and reproducing the information on a monitor (Remarks page 23) and finally that Cuervo teaches a system for dispensing cards (Remarks page 23). The references therefore disclose all the limitations and further the

examiner maintains that there is proper motivation in that it would have been obvious to someone skilled in the ordinary art at the time of invention to include the identification card taught by Lemelson to the biometrics verification method of Stinson so that a large central database of names does not need to be kept and referenced every time a person uses an ATM. If the data is stored on an individual card, provided by the user, then the system need only to read the information on the card, therefore saving memory space and money and further more producing a card is obvious so that someone using an ATM for the first time could have an identification card produced for them for future visits so they do not have to waste time in proceeding through a long verification process for each subsequent visit. Producing the card at the ATM vestibule is advantageous as well as a customer can simply perform this action once before their initial transaction as opposed to having to go out of the way to a central office to have a card generated.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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